

REMARKS

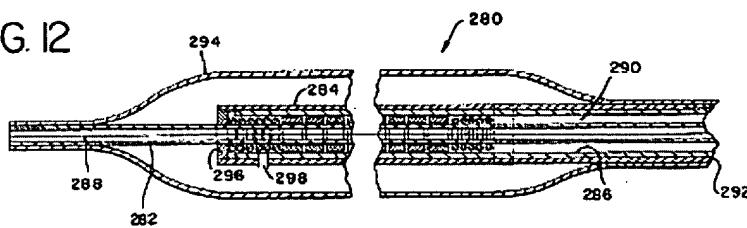
This Amendment is in response to the Office Action dated January 9, 2009. Each issue in the Office Action is addressed below.

§102 Rejections

Claims 32-35, 40, 45-47 and 50-52 were rejected under 35 USC §102(e) as being anticipated by Waksman et al. (US 5899882). It is asserted on page 3 of the Office Action that, as to claims 32-35, 40, 45-47 and 50-52, Waksman (Fig. 12, for example) discloses inner shaft 282, balloon 294 can be used with a stent (not shown) as a stent deployment balloon (col. 33, lines 18-20), rings 286 and 284 as a mounting body, stent 36, stop/marker band 296. It is asserted that ring 286 is flexible for easy navigation in a tortuous vessel and mostly a polymer. It is further asserted that a flexible polymer is mostly resilient under deformation and, inherently, ring 286 is resiliently deformable under radial pressure.

The rejection fails at least because it fails to provide for the element “the mounting body...having at least one circumferential separation in the circumferential outer surface” as required by claim 32. The rejection itself does not address this element. In the rejection, citing figure 12 (shown below), it is asserted that there is disclosed “rings 286 and 284 as a mounting body”.

FIG. 12



In column 20, lines 14-25, the reference identifies 286 and 284 as an outer tube (284) and an intermediate tube (286). These tubes 284, 286, at least from the figure, extend proximally beyond the balloon and do not touch the inner tube 282. It is also noted in lines 22-25 that “[t]he space between the intermediate tube and the outer tube 284 forms a return lumen 292 for return of liquid used to transport the treating elements.” There is no indication of a “circumferential separation” in the outer surface of either of the tubes 284, 286, which are identified as “rings” in

the rejection. As such, the rejection fails to provide for each and every element in the claimed invention.

The rejection, in addressing the element “wherein the mounting body is formed of a material which resiliently deforms under radial pressure” in claim 32, also asserts that “[a]t least, ring 286 is flexible for easy navigation in a tortuous vessel and mostly a polymer. A flexible polymer is mostly resilient under deformation. Inherently, ring 286 is resiliently [deformable] under radial pressure.”

It cannot be said that intermediate tube 286, which is called a ring in the rejection, inherently “is formed of a material which resiliently deforms under radial pressure” from the assertion in the rejection that it must at least be “flexible for easy navigation in a tortuous vessel”. This assertion speaks to the longitudinal flexibility of the “tube” such that it can longitudinally bend with the navigational bend of a vessel as the tube is pushed or pulled along the vessel. The assertion does not speak the resiliency of the outer material of the tube and whether it “resiliently deforms under radial pressure”. Lone assertions in the rejection that tube 286 is “mostly polymer” and that “a flexible polymer is mostly resilient under deformation” without support in the cited reference do not make the tube 286 inherently of “a material which resiliently deforms under radial pressure”, as required by claim 32.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The noted assertions in the rejection do not make clear that the missing descriptive matter is necessarily present in tube 286 in figure 11. The assertions are speculative and depend upon probabilities or possibilities. This is insufficient for a *prima facie* case of anticipation.

For at least the above stated reasons, Waksman et al. fails to teach or suggest all of the limitations recited in at least independent claim 32. Withdrawal of the rejection is therefore respectfully requested.

§103 Rejections

Claims 39 and 41-44 were rejected under 35 USC §103(a) as being unpatentable over Waksman et al. (US 5899882). A full account of the rejection is found on pages 3-4 of the Office Action.

Whereas claims 39 and 42-44 are dependent upon independent claim 32 and the present rejection depends upon the §102 rejection as a basis, the present rejection also fails at least for the reasons stated above regarding the §102 rejection. As such, the rejection fails to provide for each and every element of the claimed invention and does not make a *prima facie* case of obviousness.

In addition, as to claim 39, it is noted that, as mentioned above, the rejection fails to address the “at least one circumferential separation in the circumferential outer surface” of the mounting body in claim 32 and further fails to address the “plurality of separations [that] form a plurality of linearly positioned separate rings” in the present rejection of claim 39. As noted above, there is no indication of a “circumferential separation” in the outer surface of either of the tubes 284, 286, which are identified as “rings” in the rejection, let alone a “plurality of separations [that] form a plurality of linearly positioned separate rings”. As such, the rejection fails to provide for each and every element in the claimed invention. Withdrawal of the rejection is respectfully requested.

Applicant notes that claim 41 has been canceled and should not be a part of the present rejection.

Miscellaneous

Claim 32 has been amended to more clearly state the claimed subject matter.

The assertions in the Office Action that are not specifically addressed above have not been specifically addressed because it is unnecessary and moot in light of Applicant’s amendments and comments shown above. It should not be construed that Applicant acquiesces to the unaddressed assertions. Applicant reserves the right to address these assertions at a later date if needed.

Conclusion

Based on at least the above, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 32-35, 39-40, 42-47 and 50-52 as well as withdrawn dependent claims 36-38 and 48-49 is requested. Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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